

Office Action Summary	Application No. 10/712,816	Applicant(s) ROYALE ET AL.	
	Examiner BRETT FEENEY	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 and 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 September 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Change in Examiner

1. The current Examiner respectfully notes that Brett Feeney is the new Examiner for the instant application. Further correspondence should be directed to Examiner Feeney as appropriate.

Introduction

2. This **FINAL** Office action is in response to communications received on 02/04/2010 and 06/24/2010.

Status of the Claims

3. In Applicant's amendment received 02/04/2010, Claims 9 and 15 - 18 were amended. Claims 1-8 and 10-14 had been cancelled. Therefore, Claims 9 and 15-22 were currently pending. On 05/24/2010, the Examiner mailed a Notice of Non-Compliant Amendment (therefore, Applicant's amendment had not been entered), noting that Applicant had not responded to all rejections. Applicant responded to the Non-Compliant Amendment in a supplemental amendment mailed 06/24/2010 however the status of the Claims 9 and 15 - 18 were improperly indicated as previously presented. Because it is clear that Applicant's amendment mailed 06/24/2010 noting the previously presented status of Claims 9 and 15 - 18 is referring to the claim amendments presented in the amendments mailed 02/04/2010, the claim amendments are herein noted and entered. Further, the Examiner called representative for Applicant, Michael Fein, on

September 15, 2010 and confirmed the proper amendments and claims status.

Accordingly, the Examiner will examine the amended claims as presented in the amendment mailed 02/04/2010.

4. Claims 9 and 15 – 22 are currently pending.

Response to Amendments

5. Applicant's amendments to claims are herein acknowledged and entered. In response to Applicant's amendments the Examiner has entered new rejections under §101 and §112, first paragraph. Further, the Examiner has maintained the previous rejections under §112, first paragraph and §103. Further, the Examiner has withdrawn the objection to claim 9.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 9 and 15-22 are rejected** under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 9, 15 and 18, Examiner believes that undue experimentation is required to carry out the claimed invention. Specifically, steps c) and d) lack enablement. Using the Wands factors, the step of identifying "an opportunity gap" is overly broad. Examiner could not find in the specification what constitutes such a gap, and how it is identified using the information collected during step a). Additionally there is little guidance and no working examples on how optimal facility locations and optimal services are generated. What parts of the information collected during step a) are used, and how are they used? The specification merely states that it is accomplished. Finally, because of the lack of sufficient prior art, Examiner does not believe that one of ordinary skill in the art could carry out the claimed invention without undue experimentation.

Regarding claims 9, 15, 18, 21, and 22, Examiner believes that undue experimentation is required to carry out the claimed invention. Specifically, generating optimal brands, hours, design layouts, and meal plans requires undue experimentation. This step is nebulous and the claimed scope is not commensurate with the disclosure of the specification. There is no guidance and no working examples on how this is accomplished. What parts of the information collected during step a) are used, and how are they used? The specification merely states that it is accomplished. Finally, Examiner does not believe that one of ordinary skill in the art could carry out the claimed invention without undue experimentation.

Regarding claim 16, Examiner believes that undue experimentation is required to carry out the claimed invention. Specifically, generating a plan for providing,

Art Unit: 3624

updating, and/or expanding services based on population and sub/population factors requires undue experimentation. This step is nebulous and not commensurate with the disclosure of the specification. What exactly is in the plan? How detailed is it? What type of "services" are included? The specification provides no guidance and no working examples. What parts of the information collected during step a) are used, and how are they used? The specification merely states that it is accomplished.

Regarding Claims 9, 15 and 18, the claims are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Step c) of the claims recites "generating optimal facility locations and one or more optimal services", however there is no description to support how that optimal facility location or optimal services is generated. In order to demonstrate possession of, or for one of ordinary skill in the art to practice, an optimization method specific algorithms or programming steps must be described. The generic goal of providing optimal meal service plans is an output of the data gathered in steps b) and c) of the claims however there is lack of support describing any specific method for achieving that end. "Generic claim language appearing in *ipsis verbis* in the original specification does not satisfy the written description requirement if it fails to support the scope of the genus claimed" see *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co. (Fed. Cir. 2010) (en banc)*. The instant specification lacks any description of an actual reduction to practice which would be

Art Unit: 3624

evidenced by formulas, flow-charts, programming steps, etc. that are sufficiently detailed to show that Applicant was in possession of the claimed invention as a whole. Further, there is no evidence of a complete specific application or embodiment to satisfy the requirement that the description is set forth “in such full, clear, concise, and exact terms” to show possession of the claimed invention. *Fields v. Conover*, 443 F.2d 1386, 1392, 170 USPQ 276, 280 (CCPA 1971). Therefore, the step(s) encompassing generating “optimal facility locations” and “optimal services” is little more than a wish for possession; it does not satisfy the written description requirement. *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406 (written description requirement not satisfied by merely providing “a result that one might achieve if one made that invention”); *In re Wilder*, 736 F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984).

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 9 and 15 – 22 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding 9, the claim recites in step c) of the claim “generating optimal facility locations and one or more optimal services”, however it is not clear what the scope of generating optimal locations and one or more optimal services is intended to encompass. It is not clear what steps are used to perform the optimization and how is it optimized. For example, is optimization accomplished using mixed linear integer

Art Unit: 3624

programming, a discrete algorithm, a non-discrete algorithm, an approximation algorithm, an exact algorithm, parallel algorithms, distributed algorithms, and how is the data of the claims optimized using the algorithm(s) or programming steps. There does not appear to be any specific definition provided in the specification that defines the scope of how generating optimal facility locations and one or more optimal services are accomplished and accordingly the claim is vague and indefinite. The Examiner has not afforded this limitation any patentable weight. **Regarding Claims 15, 18, 16-17 and 19-22**, these claims are rejected for similar reasons as **Claim 9** because they recite the same limitation (**15** and **18**) or depend from **Claims 9, 15 or 18**.

Regarding 18, the claim recites a computer in steps a, b and d. However it is not clear whether the a computer is the same "a computer" where it should properly recite "the computer" in steps b and d or if steps b and d should be direct to "a second computer" and "a third computer" respectively. Appropriate correction is required.

Rejections under § U.S.C. 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 9 and 15 – 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

12. The claimed invention is directed to abstract ideas, abstract concepts and the like and is not directed to one of the four categories of §101. Therefore, the recited method, system and software are held to be barred at the threshold by §101 *in re*

Comiskey, 554 F.3d 967.973 (Fed. Cir. 2009) (citing *Diamond v. Diehr*, 450 US 175,188 (1981)). Step (c) of independent Claim 18 is not tied to another statutory category, such as a computer and therefore the idea of generating optimal services may be simply performed in one's own mind. Further, the step(s) of using a computer in steps (a) and (b) is extra solution activity and the steps of gathering data would be performed the same using a pen and paper, having an oral discussion, etc. Claims 9 and 15 suffer from a similar defect in that they are directed to a computer readable medium and system, however the claimed statutory category is mere semantic substitution and the steps noted *supra* and are not tied to the category itself.

13. The claimed invention is directed to abstract ideas and therefore *de facto* not directed to one of the four categories of §101. The court has held that “[i]f the claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of §101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007); accord *In re Ferguson*, 558 F.3d 1359 (Fed. Cir. 2009). Further the “the unpatentability of abstract ideas was confirmed by the U.S. Supreme Court in *Bilski v. Kappos*, No. 08-964, 2010 WL 2555192 (June 28, 2010)”
14. Step c) of independent Claim 18 is directed to every practical application of the idea of meal service planning. The claimed optimal facility location and one or more optimal services are directed to use of a concept, as expressed in the method, and would effectively grant a monopoly over the concept of meal

services planning. The claim encompasses any and all known and unknown uses of the concept and merely is a statement of the problem being solved. Accordingly, it is pre-emptive of an entire field of endeavor and lacks a specific practical application of the same. One may not patent such an idea "because such a patent would "in practical effect be a patent on the [idea, law of nature or natural phenomena] itself." *Gottschalk v. Benson*, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972)." Citing MPEP § 2106. Step c) of Claims 9 and 15 suffer from the same defect, noting the step is the same.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claims 9 and 15-22 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Halverson US2002/0077843 (herein Halverson) in view of Snyder et al. US2008/0057482 (herein Snyder) and Fox US2003/0028417 (herein Fox).

Regarding Claim 9, Halverson discloses an article comprising a computer readable medium having computer program code tangibly stored thereon executable by a computer comprising a set of instructions (par. 2) for assessing institutional food service needs on a university campus according to the following steps:

Art Unit: 3624

a) inputting data regarding: (the Examiner respectfully notes that the data that is input in a)- 1) to 4) is non-functional. Therefore, the data that is recited in steps 1-4 is directed to non-functional descriptive material that is not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP §2106. In an effort to advance prosecution the Examiner has mapped exemplary data disclosed by the cited references and how the specific data is used to generate an optimal service.)

3) population comprising: location, time, purpose, and schedules of individuals (par. 39, lines 9-11, fig. 8-12 are surveys and preferences, par. 58-61, the example is given where for a state fair, geographically proximate areas with similar populations and uses are grouped into a single unit, e.g. nearby people who like arts and crafts, nearby people who like large animal exhibits, etc.);

4) food service preferences and desires comprising: dining style, meal-type, grocery, food types, desired services, desired eating and snacking times, and food preferences (fig. 8-12); and

5) existing services comprising location of services, on-campus services, off-campus services, satisfaction, and type of services (par. 43, for example, available meal

Art Unit: 3624

locations, capabilities and equipment of the facilities (sound generation), fig. 8-11, surveys provide satisfaction);

b) segmenting the campus into geographic units and day parts (par. 39, several examples of segmenting are given, such as primary segmenting based on preference for group or individual seating, and then secondary segmenting based on preference for music or sounds);

c) identifying an opportunity gap (par. 39, lines 21-46, as an example, seating preferences are identified as a preference not being met and interpreted as an opportunity by management to increase value of the dining experience); and

d) for each geographic unit and day part, generating one or more optimal services to the facility locations and day parts selected from the group consisting of hours, design layouts, and meal plans (par. 39, fig. 8-12).

Halverson does not teach:

1) location of buildings, roads, landscape features, traffic patterns, travel time between buildings, and obstacles or impediments to travel;

2) location, attendance rates, and schedule of each building;

c) for each geographic unit and day part, generating optimal facility locations and one or more optimal services to the facility locations selected from the group consisting of brands; and

d) generating a financial model for each of said optimal facility locations.

In analogous art, Snyder teaches:

Art Unit: 3624

1) location of buildings, roads, landscape features, traffic patterns, travel time between buildings, and obstacles or impediments to travel (par. 16, information on location of buildings and travel time between buildings is collected); and

2) use, location, attendance rates, and schedule of each building (par. 16, information on preferences and resource-based use of buildings is collected, par. 170, location of buildings is gathered to calculate distance between buildings, par. 15, collection of attendance information, par. 16, schedule of classes in building is collected and optimized).

The inventions of Halverson and Snyder pertain to collecting demographic information to optimize the services of an institution. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, as Snyder does not teach away from or contradict Halverson, but rather, teaches a function that was not addressed. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by increased efficiency in the services of the institution provided by taking into account as much information about the community as possible, as recognized by Halverson (par. 43, lines 59-62).

Neither Halverson nor Snyder teaches:

Art Unit: 3624

- c) for each geographic unit, generating optimal facility locations and one or more optimal services to the facility locations selected from the group consisting of brands; and
- d) generating a financial model for each of said optimal facility locations.

In analogous art Fox teaches:

- d) for each geographic unit, generating optimal facility locations (par. 16, 17) and one or more optimal services to the facility locations selected from the group consisting of brands (par. 43); and
- e) generating a financial model for each of said optimal facility locations (par. 16, 17).

The inventions of Halverson, Snyder, and Fox pertain to improving existing services. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, as Fox does not teach away from or contradict either Halverson or Snyder, but rather, teaches a function that was not addressed. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the need expressed in Fox of expanding and/or contracting service locations in addition to improving them at current locations (par. 16, 17).

Claim 15 recites limitations that are substantially similar to Claim 9 *supra* therefore Claim 15 is rejected for similar reasons. Further, regarding claim 15,

Art Unit: 3624

Halverson teaches a computer system for managing a campus food service system (Abstract) comprising:

a database (fig. 1); and

a computer including the computer readable medium of claim 9 (see claim 9), programmed to optimize the campus food service system based on responses to surveys of patrons and potential patrons,

the database including records of facilities, staff, menu options, times of services, campus calendar, and the responses comprising patron and potential patron preferences, wherein the computer system generates, in addition to the facility locations and financial models, schedules of menu items, staff, and service times for each dining facility (par. 39, fig. 8-12).

Regarding claim 18, Claim 18 recites limitations that a substantially similar to claims 15 and 18 above. Therefore Claim 18 is rejected for the same reasons.

Regarding claim 16, neither Halverson nor Snyder teach generating a plan for providing, updating, and/or expanding services based on population and sub/population factors.

Fox teaches generating a plan for providing, updating, and/or expanding services based on population and sub/population factors (par. 16, 17).

The inventions of Halverson, Snyder, and Fox pertain to improving existing services. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, as Fox does not teach away from or contradict either

Art Unit: 3624

Halverson or Snyder, but rather, teaches a function that was not addressed. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the need expressed in Fox of expanding and/or contracting service locations in addition to improving them at current locations (par. 16, 17).

Regarding claim 17, Halverson teaches wherein the campus is a university campus (par. 15, 39).

Regarding 19, they are rejected using the same art and rationale used above for rejecting Claim 17.

Regarding claim 20, Halverson teaches using a computer to generate schedules of menu items and staff for each at least one dining facility on the campus (par. 39, fig. 8-12).

Regarding claims 21 and 22, Halverson teaches generating optimal hours, design layouts, and meal plans corresponding to the facility locations (par. 39, fig. 8-12).

Halverson does not teach generating optimal brands corresponding to the facility locations.

Fox teaches generating optimal brands corresponding to the facility locations (par. 16, 17, 43).

The inventions of Halverson, Snyder, and Fox pertain to improving existing services. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in

Art Unit: 3624

their respective functions, as Fox does not teach away from or contradict either Halverson or Snyder, but rather, teaches a function that was not addressed. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the need expressed in Fox of expanding and/or contracting service locations in addition to improving them at current locations (par. 16, 17).

Response to Arguments

17. Applicant's arguments received on 02/04/2010 and 06/24/2010 have been fully considered but they are not persuasive. Applicants argues:

- i) The claims are enabled and no undue experimentation would be required to practice the invention.
- ii) Halverson, Snyder and Fox are non-analogous art in respect to the instant invention.
- iii) Aramark's MarketMatch has achieved a commercial success and solved a long-felt need and has therefore overcome the *prima facie* case of obviousness.

In response to argument i) that the claims are enabled and no undue experimentation would be required to practice the invention, the Examiner respectfully disagrees. As noted in the rejection under §112 *supra*, the claims are not enabled by

Art Unit: 3624

the specification for at least three reasons. First, the claims would require experimentation for an ordinary artisan to practice the invention. Applicant has not provided any evidence to demonstrate where specifically in the disclosure the instant claimed invention enables an ordinary artisan to practice the invention. Second, the scope of the claimed invention is not commensurate with the disclosure. Applicant has not provided any working examples (neither generic nor specific) that would enable an ordinary artisan to practice the invention. Third, there is no written description that shows possession of the claimed invention, at the time the application was filed and therefore one of ordinary skill in the art would not have been enabled to make and use something that is not described. Accordingly, the claims remain rejected under §112, first paragraph for lacking enablement.

In response to argument ii) that Halverson, Snyder and Fox are non-analogous art in respect to the instant invention, the Examiner respectfully disagrees. First, the Examiner disagrees with the assertion that that Halverson, Snyder and Fox are non-analogous art because that Halverson, Snyder and Fox are directed toward solving similar problems of optimizing services based on the demographics in which they serve. Further evidence of the analogousness of the cited art and the instant invention is that they have all been assigned to class 705 in the united states patent office. Further, even if *arguendo* Applicant were correct in the assertion that Halverson, Snyder and Fox are non-analogous art, which the Examiner does not concede, the Examiner respectfully notes “[t]he use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of

Art Unit: 3624

the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). See also *Upsher-Smith Labs. v. Pamlab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005). Accordingly, the claims remain rejected under §103.

In response to argument iii) that Aramark's MarketMatch has achieved a commercial success and solved a long-felt need and has therefore overcome the *prima facie* case of obviousness, the Examiner respectfully disagrees. While it may be true that MarketMatch has achieved significant commercial success and solved a long felt need, there is no evidence in the 1.132 affidavit that draws a correlation between the claimed features presented in the instant application and the commercial success nor the long-felt need. Further, the evidence generally appears to be directed to the commercial success of MarketMatch, and therefore the Examiner will address the evidence. In order for the secondary considerations to be considered persuasive, Applicant must show evidence as to how the specific claimed features resulted in commercial success of the product. For evidence of commercial success to be considered relevant “applicant should establish a nexus between the rebuttal evidence and the claimed invention” MPEP § 2145. See *In re Huang*, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). See also *GPAC*, 57 F.3d at 1580, 35 USPQ2d at

Art Unit: 3624

1121; *In re Paulsen*, 30 F. 3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994).

Therefore, the evidence that Aramark's MarketMatch has achieved a commercial success and solved a long-felt need and has therefore overcome the *prima facie* case of obviousness is not persuasive the rejection under §103 is maintained.

Requirement for information – Public use or sale

18. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows:

- All software specifications, user manuals, detailed descriptions of services offered and rendered relating to MarketMatch process sold by Aramark at least as early as September 19, 2002.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Conclusion

The references cited in the form PTO-892 were not applied under relevant sections of §102 or §103 in the above Office action, however they are considered relevant to both claimed and unclaimed features of the instant invention. Applicant is herein advised to review the cited prior art references prior to responding to the instant Office action in order to expedite prosecution of the instant application.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Brett Feeney** whose telephone number is **571.270.5484**. The Examiner can normally be reached on Monday-Thursday, 7:30am-6:30pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Lynda Jasmin** can be reached at **571.272.6782**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/BRETT FEENEY/

Examiner, Art Unit 3624

/LYNDA C JASMIN/

Supervisory Patent Examiner, Art Unit 3624